

Office Action Summary

Application No.

10/007,812

Applicant(s)

SUPINSKI, ROBERT S.

Examiner

DAVID COMSTOCK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/6/09 and interview on 1/13/10.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1 and 3-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20100113</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

QUAYLE ACTION

This application is in condition for allowance except for the formal matters noted below in this action.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Applicant has suggested an interference with U.S. Pat. No. 6,146,423, pursuant to 37 CFR 41.202(a) in a communication filed 09 January 2004. The suggested interference originally covered claims 1-21 and did not extend to claims 22-26. In addition, Applicant agreed in an interview on 13 January 2010 to an Examiner's Amendment to place the claims into condition for allowance, subject to matters pertaining to the potential interference. Accordingly, this action includes an Examiner's Amendment to the claims and reasons for allowance, a requirement to satisfy all formal matters with regard to consideration of the request for interference, and a restriction requirement between the potentially interfering claims and the non-interfering claims.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312.

Authorization for this examiner's amendment was given in a telephone interview with Lynn Alstadt on 13 January 2010.

The application has been amended as follows:

Claim 1, line 6, after "therein;", "and" has been deleted.

Claim 1, line 10, after "patient;", the following has been inserted:

--and

an annular ring having a central aperture for coupling to said flat surface of said first member and having a plurality of apertures about a periphery of said ring, the periphery encircling the rounded fixation surface and extending from a peripheral edge of said first member;--

Claim 2 has been canceled.

Claim 3, line 1, "2" has been changed to --1--.

Claim 22, line 8, after "second member;", "and" has been deleted.

Claim 22, line 10, after "second member;", the following has been inserted:

--and

an annular ring having a central aperture for coupling to said flat surface of said first member and having a plurality of apertures about a periphery of said ring, the periphery encircling the rounded fixation surface and extending from a peripheral edge of said first member;--

The following is an examiner's statement of reasons for allowance:

Upon further consideration of the arguments in the Appeal Brief filed 09 February 2009, and the art pertaining thereto, the outstanding grounds of rejection are withdrawn. See arguments, e.g., page 2, lines 17-20; page 8, lines 3-8 and 15-19; and page 10, lines 19-21 (in the Thomas reference, upon which all the rejections depend, there is no peripheral gap between the attachment part and the prosthesis part as claimed (claims 8 and 15), and there is no ring extending from a peripheral edge of the first member as

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claimed (claim 15 and claims 1 and 22 as now amended to include the limitations of claim 2)). Moreover, Thomas et al. teaches a porous coating but not a porous metal material. However, it is noted that Applicant's arguments at page 8, lines 11-14 are not persuasive. Thomas et al. is deemed to have a shape "conforming to a natural patella" at least because it literally conforms to a resected, remaining portion of a patella. Applicant agreed to amend independent claim 1 to include the limitations of claim 2 to overcome a potential rejection over Thomas et al. (5,522,901) in view of Collier (4,156,943; teaching that a totally porous metal could be substituted for a metal comprising only a porous surface (see, e.g., col. 2, lines 13-15; col. 3, lines 35-42; and col. 4, lines 41-34)). Applicant further agreed to amend claim 22 to include the limitations of claim 2 to overcome a potential amended rejection over Thomas et al. (5,522,901) in view of Johnson (5,609,640; teaching the bone growth material) (amended to clarify the Examiner's position noted above with regard to the shape "conforming to a natural patella"). Neither the art of record nor other known references disclose or render obvious all the limitations of claims 8 and 15 and amended claims 1 and 22; accordingly, these claims stand allowable over the prior art of record, subject to matters pertaining to Applicant's request for interference.

Interference

As noted above, Applicant has suggested an interference with U.S. Pat. No. 6,146,423, pursuant to 37 CFR 41.202(a) in a communication filed 09 January 2004. The suggested interference originally covered claims 1-21 and did not extend to claims 22-26. Moreover, claim 2 is now canceled, claims 1 and 3 have been amended, and

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claim 22 is amended and still not within the request for interference. Applicant is required to address the following matters pertaining to the request for interference:

Applicant is required to (1) identify all claims the applicant believes interfere, and/or (2) propose one or more counts, and/or (3) show how the claims individually correspond to the one or more counts. See 37 CFR 41.202(a)(2) and MPEP § 2304.02(b). Note that the identification in the communication filed 09 January 2004 is not directed to the current claims.

Applicant is required to provide a claim chart comparing at least one claim of each party corresponding to the count. See 37 CFR 41.202(a)(3) and MPEP § 2304.02(c). Note that the chart filed 04 August 2004 is not directed to the current claims.

Applicant is also required to provide a detailed explanation as to why applicant will prevail on priority. See 37 CFR 41.202(a)(4), (a)(6), (d) and MPEP § 2304.02(c).

Thus, the request for interference filed 09 January 2004 is acknowledged; however, Applicant is required to address the formal matters in this action before further consideration of the potential interference. See 37 CFR 41.102(a) and MPEP § 2303.

Election/Restrictions

This application contains claims directed to potentially interfering claims and non-interfering claims as follows:

- I. Potentially interfering claims (1, as amended, and 3-21)
- II. Non-interfering claims (22, as amended, and 23-26)

Applicant is required under 35 U.S.C. 121 to elect a single group of claims for further prosecution (see MPEP 2303). In order to avoid delay in the potential initiation

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of an interference, Applicant may also cancel the non-interfering claims and refile them in a continuation application. Patent term adjustments are available for any patents whose issuance has been delayed for an interference. 35 U.S.C. 154(b)(1)(C)(i). A claim that does not interfere, by definition, is directed to a patentably distinct invention compared to a claim that does interfere. It is noted that leaving the non-interfering claims in the application going into a potential interference creates a delay in the issuance of claims to the non-interfering subject matter.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a group of claims to be examined even though the requirement may be traversed (37 CFR 1.143). The election of the claims may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144.

Conclusion

As noted above, prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-

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4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733